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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/754,380	01/09/2004	Bradford W. Shaw	451490	7804

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Harold V. Stotland  
Seyfarth Shaw LLP  
Suite 4200  
55 East Monroe Street  
Chicago, IL 60603-5803

EXAMINER

PICKETT, JOHN G

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

6

<b>Office Action Summary</b>	<b>Application No.</b> 10/754,380	<b>Applicant(s)</b> SHAW ET AL.	
	<b>Examiner</b> Gregory Pickett	<b>Art Unit</b> 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 June 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16, 18 and 19 is/are rejected.
- 7) ☒ Claim(s) 17 and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Office Action acknowledges the applicant's amendment submitted 7 June 2005. Claims 1-20 are pending in the application.
2. As the examiner introduces new grounds of rejection, this Office Action is made **NON-FINAL**.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Rejections - 35 USC § 112***

4. In light of the applicant's amendment, the rejection of claim 20 under 35 USC 112, 2<sup>nd</sup> paragraph, is hereby withdrawn.

#### ***Claim Rejections - 35 USC § 102***

5. Claims 1, 2, and 4-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Gagliardi, Jr. (US 2001/0030139 A1; hereinafter Gagliardi).

Claim 1: Gagliardi discloses a cooking utensil **10** with a base wall **14**, an upstanding, integral peripheral wall (see Figure 2), a peripheral flange **16**, a set of indicia **28** on flange **16**, including plural first indicia (numerals "1") and plural second indicia (numerals "4"), equidistantly spaced and alternating as claimed.

Claims 2 and 6: Gagliardi discloses indicia disposed directly opposite each other (as shown, Figure 1).

Claim 4: Gagliardi discloses the indicia spaced as claimed (see Figure 1).

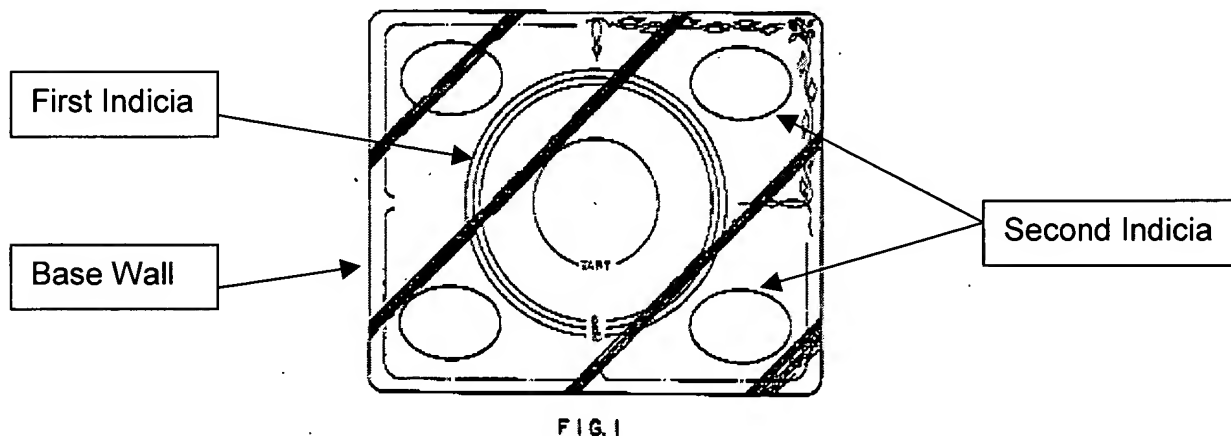
Claim 5: Gagliardi discloses a circular shape (see Figure 1).

Claim 7: Gagliardi discloses indicia **28** disposed as claimed (see Figure 1).

Claim 8: Gagliardi discloses additional indicia **26**.

6. Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by Mortland (Des. 206,757).

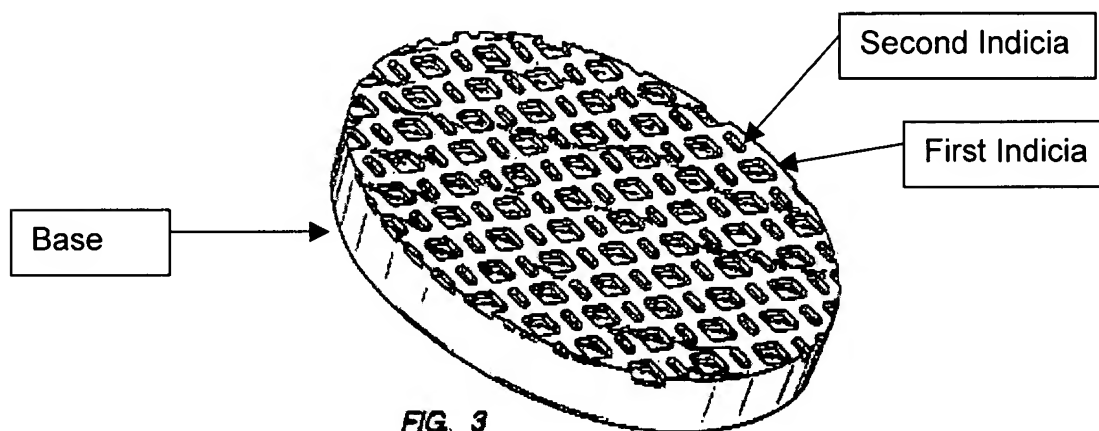
Claim 14: Mortland discloses a cooking utensil (pastry sheet) with a base wall having a planar upper surface (see Figure 2), plural evenly spaced first indicia (see below), and plural evenly spaced second indicia (see below). The centers of each of the first and second indicia are equidistantly spaced as claimed.



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7. Claims 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Rossiaud (Des. 372,394).

Claim 14: Rossiaud discloses a base (see below) with a flat planar upper surface, a plurality of evenly spaced, non-raised first indicia (see below), and a plurality of evenly spaced, non-raised second indicia (see below). The indicia of Rossiaud are equidistantly spaced as claimed.



### ***Claim Rejections - 35 USC § 103***

8. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagandt (US 476,340) in view of Gerard et al (US 3,724,654).

Claims 1, 5, and 7: Wagandt discloses a cooking utensil with a circular base wall 1, an upstanding peripheral wall 2, a peripheral flange 3, and a set of indicia 7 equidistantly disposed on the upper surface of flange 3.

Wagandt merely lacks a second set of indicia.

Gerard et al discloses indicia **23 & 25** used to discreetly identify the retained items. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the utensil of Wagandt with identifying indicia as taught by Gerard et al in order to identify the individual portions.

Claims 2, 4, and 6: Gerard et al centrally locates the indicia on the retention pockets and it would have been obvious to maintain this central location for the indicia on the utensil of Wagandt-Gerard for aesthetic purposes. Such an arrangement would have the claimed opposed, equidistant relationship.

Claim 3: concerning the size of the indicia, it would have been an obvious matter of design choice to provide the indicia in differing sizes, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wagandt-Gerard as applied to claim 1 above, and further in view of Riener (US 2,802,411).

Wagandt-Gerard discloses the claimed invention except for the additional indicia on the base wall.

Riener discloses indicia **12 & 13** on the upper surface of the base wall. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the utensil of Wagandt-Gerard with additional indicia as taught by Riener in order to stiffen the base wall.

10. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caputo (US 6,745,660) in view of Gerard et al (US 3,724,654).

Claims 9 and 12: Caputo discloses a utensil **20** with a rectangular base wall **22**, an upstanding peripheral wall **24**, a peripheral flange **26**, and a set of indicia **40** equidistantly spaced on the upper surface of flange **26**.

Caputo merely lacks a second set of indicia.

Gerard et al discloses a set of indicia **23 & 25** used to discreetly identify the retained items. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the utensil of Caputo with identifying indicia as taught by Gerard et al in order to identify the individual portions.

Claim 10: concerning the size of the indicia, it would have been an obvious matter of design choice to provide the indicia in differing sizes, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Claim 11: Gerard et al centrally locates the indicia on the retention pockets and it would have been obvious to maintain this central location for the indicia on the utensil of Caputo-Gerard for aesthetic purposes. Such an arrangement would have the claimed opposed, equidistant relationship.

11. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Caputo-Gerard as applied to claim 9 above, and further in view of Saleeba (US 4,452,419).

Caputo-Gerard discloses the claimed invention except for the additional indicia on the base wall.

Saleeba discloses indicia **31** on the upper surface of the base wall. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the utensil of Caputo-Gerard with additional indicia as taught by Saleeba in order to stiffen the base wall.

12. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mortland as applied in section 6 above, and further in view of Fritz (Des. 253,449).

Claim 18: Mortland merely lacks the circular second indicia. Fritz discloses that it was desirable to change the shape of surrounding second indicia. It would have been an obvious matter of design choice to one of ordinary skill in the art at the time the invention was made to change to shape of the second indicia of Mortland to any geometric shape, including a circle, in order to alter the appeal of the sheet. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47. A change in aesthetic (ornamental) design generally will not support patentability. *In re Seid*, 73 USPQ 431.

Claim 19: the first indicia of Mortland are concentric circles (see above).



***Allowable Subject Matter***

13. Claims 17 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

***Response to Arguments***

15. Applicant's arguments, see pages 7-9, filed 7 June 2005, with respect to the rejection(s) of claim(s) 14-16, 18, and 20 under 35 USC 102(b) in view of Riener and Krupa, have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art presented above.

16. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re*

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*Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion can be found in Gerard et al (see Col. 2, lines 41-45).

17. Applicant's arguments concerning the well known "King's Cake" have been fully considered but are moot in view of its removal from the rejection.

18. In response to applicant's argument that Gerard et al is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Gerard et al is reasonably pertinent to indicia on tray flanges.

### ***Conclusion***

19. As the examiner presents new grounds of rejection, this Office Action is made **NON-FINAL**.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Greg Pickett  
Examiner  
9 August 2005



Mickey Yu  
Supervisory Patent Examiner  
Group 3700